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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/046,062 | 01/11/2002 | Richard N. Marsh | P1396 | 2792 |
| 24394 | 7590 | 11/17/2003 | EXAMINER | |
| LARIVIERE, GRUBMAN & PAYNE, LLP 19 UPPER RAGSDALE DRIVE SUITE 200 MONTEREY, CA 93940 | | | BENENSON, BORIS | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2836 | |

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,062

Applicant(s)

MARSH ET AL.

Examiner

Boris Benenson

Art Unit

2836

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Specification

1. The disclosure is objected to because of the following informalities: Disclosure indicated that distribution of an output voltage is prevented, if a hazardous condition such as an accidental reversal of the hot line wire with the neutral wire is occurred. An explanation of that statement should be given or statement removed.

Appropriate correction is required.

MPEP CFR § 1.71 provide "Detailed description and specification of the invention".

Material of paragraph 28(Page 10, Lines 10-29) does not provide a written description of the invention, does not set forth the precise invention for which a patent is solicited or provides other specifics of the invention and must be removed.

Claim Objections

2. Claims 1 and 4 are objected to because of the following informalities: Claim stated that the hot line and the neutral line are distributed as an output voltage when the overvoltage protection circuits are functioning, and whereby, in event of an over-voltage condition at least one of the first, second, third and fourth over-voltage protection circuits responds by passing

sufficient current to cause a protective device to open. It is not clear if opening of fuse TF5 due hot the line to the ground line or the neutral line to the ground over-voltage constitutes non-functioning, at least temporary, of some of over-voltage protection circuits and therefore require an interruption in distribution of the output voltage. It is not clear what protection device (TF5), being disposed in parallel with the neutral and the ground lines or in parallel with the neutral and the ground lines, is protecting the load or MOV1 and MOV4. Appropriate correction is required.

3. Claim 19 is objected as a duplicate of Claim 18.

Claim Rejections - 35 USC § 112

4. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Claim includes a limitation "the hot line and the neutral line are not distributed as an output voltage" in event of an over-voltage condition on the hot line. To achieve that fuse TF6 and TF3 should be open simultaneously or TF6 open before opening TF3.

Figure 1 indicates that TF3 and TF6 both have 15A amperage, but TF3 is exposed to a summary current (through MOV2 and MOV3) and therefore could be open first. In such case the neutral line will be interrupted, but the hot line continue to be distributed to the output.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (4,901,183) in view of Jeffries et al. (6,055,147). Lee disclosed a surge protection device that comprised a first protective circuit (Fig.1, Pos. M3) disposed between a hot line and a ground line, a second protective circuit (M1) disposed between the hot line and a neutral line and third protective circuit (M2) disposed between the neutral line and the ground line whereby the hot line and the neutral line are distributed as an output voltage when the overvoltage

protection circuits are functioning and, in event of an over-voltage condition, at least one of protective circuits is responding by passing a sufficient current to open a protective device (F1, F2). Lee did not disclose two over-voltage protection circuits connected in parallel between the hot line and the neutral line.

Jeffries teaches an apparatus for providing independent over-current protection to a plurality of electrical devices and transient-voltage suppression system employing the apparatus where connected in parallel "transient suppressing elements (Fig.1, Pos. 112) provide phase-to-neutral transient suppression" (Col.5, Lines 5-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified a surge protection device of Lee (4,901,183) with teachings of Jeffries et al. (6,055,147) connecting in parallel transient suppressing elements, because it will allow an increase in a current capacity of the protection circuit.

Referring to Claim 7, 13 and 17, Lee teaches that "it will be understood that many modifications, such as the use of circuit breakers, manual ON/OFF switches, power indicators, failure indicators and the like, will be readily apparent to those of ordinary skill in the art" (Col.6, Lines 43-46).

Referring to Claims 2,6,9 and 14, Lee disclosed use of fast-blow fuse (Abstract) and use of circuit breakers.

Referring to Claim 3, Lee disclosed use of power indicators and failure indicators.

Referring to Claims 5, 10, 15 and 18, Lee disclosed: "RFI and EMI limiting through an LC combination forming a filter circuit" (Col.3, Lines 33-34).

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Benenson whose telephone number is (703) 305-6917. The examiner can normally be reached on M-F (8:20-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (703) 308-3119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Boris Benenson
Examiner
Art Unit 2836

BRIAN SIRCUS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

